

Appln. No.: 09/479,979
Amendment dated September 8, 2003
Reply to Office Action of May 8, 2003



SC
#17
9-23 03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

William HILL et al.

Serial No.: 09/479,979

Filed: January 10, 2000

For: METHOD AND SYSTEM FOR
DYNAMICALLY ADAPTING THE
LAYOUT OF A DOCUMENT TO AN
OUTPUT DEVICE

Atty. Docket No.: 003797.00335

Group Art Unit: 2176

Examiner: C. Huynh

Confirmation No.: 3757

RECEIVED

SEP 11 2003

RESPONSE UNDER 37 CFR 1.111

Technology Center 2100

MAIL STOP NON-FEE AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The office action of May 8, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 35-53 remain pending in this application.

Claims 35 - 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spyglass Prism, Concepts and Applications (pages 1-8) and Spyglass Prism 1.0 (pages 1 and 2), 3/1997 (hereinafter Spyglass) in view of *Elements of Editorial Style For Computer-Delivered Information*, IEEE, March 1990 to Carliner. Applicants respectfully traverse this rejection.

Applicants submit that the action has failed to establish that the Spyglass Prism documents qualify as prior art under 35 U.S.C. § 103(a). As discussed in the previous response, the copyright notice for each of the applied Spyglass Prism documents merely indicates that the documents were published in 1997. In an attempt to establish a specific date in 1997, the action contends that a press release dated March 10, 1997 announcing the debut of that Spyglass Prism product on March 10, 1997 somehow authenticates the publication date for the Spyglass Prism documents applied in the action. Particularly, in dismissing applicants' arguments that the

Spyglass Prism documents do not qualify as prior art without further evidence as to their publication date, on page 10 of the current action, the action states:

The debut of Spyglass Prism product was March 10, 1997. The Spyglass Prism document, which described the capabilities of said product, therefore, should be at least available to the public as of that date.

(Emphasis original).

Notwithstanding the action's contention, the mere fact that the Spyglass Prism product was announced on March 10, 1997 does not evidence that an enabling disclosure was available to the public as of that date. The action seems to believe that the Spyglass Prism documents should have been available to the public as of March 10, 1997. However, whether or not the documents should have been available is not relevant, the significant issue is what was actually available. Thus, the action has engaged in impermissible conjecture and failed to provide any corroborating evidence showing the routine business practices of Spyglass to establish a specific date on which the Spyglass Prism documents would have been published and available to the public. The only thing that is known is that a press release was made regarding the debut of the Spyglass Prism product on March 10, 1997. Other than the actual content of the press release, no specific evidence as to what was available to one of ordinary skill in the art as of March 10, 1997, or even applicants' priority date of April 24, 1997 has been provided.

Thus, applicants are unable to verify that the Spyglass Prism documents qualify as prior art to the instant application and if they do, what date applicants would need to establish as a date of invention in order to swear behind the documents. This uncertainty further buttresses applicants' contention that, without some corroboration as to the date of the Spyglass Prism documents, their use as prior art in rejecting the present invention is improper.

In view of the foregoing, all the claims are patentably distinct from the prior art of record.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Appln. No.: 09/479,979
Amendment dated September 8, 2003
Reply to Office Action of May 8, 2003

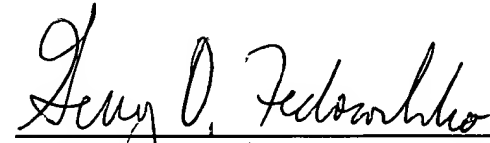
All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: September 8, 2003

By:



Gary D. Fedorochko
Registration No. 35,509

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001
GDF:lab